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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,051	04/26/2001	Masahiko Miyamoto	03409.0066	6514
22852	7590	09/20/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,051

Applicant(s)

MIYAMOTO, MASAHIKO

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

This Office action is responsive to communication received 05/19/2004 –
Request for Reconsideration.

Claims 1, 3, 4, 6, 12 and 13 remain pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12 STAND rejected under 35 U.S.C. 102(b) as being anticipated by
Thomson, as set forth in the last Office action, mailed 07/16/2003.

Claims 4 and 13 STAND rejected under 35 U.S.C. 103(a) as being unpatentable
over Thomson in view of Reuter, as set forth in the last Office action, mailed
07/16/2003.

Claims 1, 3, 4, 6, 12 and 13 STAND rejected under 35 U.S.C. §103(a) as being
unpatentable over Werner in view of Masghati, as set forth in the last Office action,
mailed 07/16/2003.

RESPONSE TO ARGUMENTS

In the arguments received 05/19/2004, the applicant contends that the prior art reference to Thomson does not anticipate the claimed invention since according to the applicant Thomson fails to disclose a boundary line across the position of the sweet spot. The applicant argues that Thomson instead shows a curved middle portion (35) through which a horizontal line might be drawn if the skilled artisan were inclined to designate that the sweet spot falls within the middle curved portion. In addition, the applicant argues again that the combination of Werner and Masghati to reject the claims is misplaced, as the skilled artisan, in the opinion of the applicant, would not be inclined to use the Masghati teaching to modify only a portion of the Werner striking face.

In response to these arguments, it is noted that applicant's base claim 1 is cast in open terminology. The applicant's claims require that the golf club head comprise a face having upper and lower portions separated by a boundary line, with the upper and lower portions differing in the value of the roll radius. It would not be unrealistic to conclude that a horizontal plane passing through axis (37) in the Thomson device would intersect the middle curved portion (35) generally centrally and would as such intersect the sweet spot of the clubface. Note Figures 1, 2 and 5 in Thomson showing that the most optimal location on the clubface for striking the golf ball (i.e., the sweet spot) is indeed located generally centrally of the curved middle portion (35). Admittedly, this configuration would leave a portion of the middle curved portion (35) above a boundary line that crosses the sweet spot of the face and would also leave a portion of the middle curved portion below the boundary line that contains the sweet spot. However,

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independent claim 1 only requires that the claimed invention comprise an upper portion having a roll radius of 305 mm or less and a lower portion having a roll radius of 310 mm or more. Thomson at a minimum shows an upper roll radius for portion (39) that is about 0.700 inch, which meets the claimed limitation requiring a roll radius of 305 mm or less. Similarly, Thomson shows at a minimum a lower portion that includes a flat or planar surface (41), which meets the claimed limitation that the lower portion have a roll radius of 310 mm or more. There is nothing in the claims that precludes the existence of more than one roll radius for either the upper or lower portions of the head. A similar observation may be made with respect to the combination of Werner and Masghati. In fact, Werner explicitly indicates that more than one curvature may exist on the face. It is not agreed that the skilled artisan would only find to use the teaching reference to Masghati to modify the entirety of the roll radius in the Werner device. Rather, Masghati is relied upon solely to teach that a roll radius within the range claimed by the applicant is in fact a roll radius that would have some sort of utility in a "wood" or "wood-type" club head. Further, Masghati is relied upon to show that the value of the roll used is variable based upon the loft angle. There is nothing in the combination of Werner and Masghati that would have precluded the skilled artisan from borrowing a teaching of a particular value for a roll radius from Masghati or simply gleaning the motivation for changing the roll radius from Masghati in order to change the roll radius of only one portion (the upper portion) of the Werner device. Of further interest, it is noted that the case law and arguments accompanying the last rejection, mailed 07/16/2003 are still deemed to be applicable.

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No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
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S.Passaniti/sp
September 15, 2004